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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/723,056	JANIA, FRANK L.
	Examiner	Art Unit	
	Michael H. Goldman	4127	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 November 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>25 November 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/2003</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is a first Office Action Non-Final on the merits. Claims 1-21,

as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

In claim 2, lines 2 and 4 claims "said computer system". There is insufficient

basis for this limitation in the claims.

In claim 2, line 11 claims "said settings". There is insufficient basis for this

limitation in the claims.

In claim 6, line 4 claims "said user". There is insufficient basis for this limitation in

the claims.

In claim 6, line 4 claims "said computer system". There is insufficient basis for

this limitation in the claims.

In claim 6, line 5 claims "said computer screen". There is insufficient basis for

this limitation in the claims.

In claim 9, lines 3, 5 and 6 claims "said computer system". There is insufficient

basis for this limitation in the claims.

In claim 13, line 4 claims "said computer system". There is insufficient basis for this limitation in the claims.

In claim 13, line 5 claims "said computer screen". There is insufficient basis for this limitation in the claims.

In claim 15, line 2 claims "said system". There is insufficient basis for this limitation in the claims.

In claim 20, line 4 claims "said user". There is insufficient basis for this limitation in the claims.

In claim 20, line 4 claims "said computer system". There is insufficient basis for this limitation.

In claim 20, line 5 claims "said computer screen". There is insufficient basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Schiff et al. (20030158777).

As per claim 1, Schiff et al. discloses a system and method for filtering content presented on a computer, comprising:

selecting an *application* (via messaging application) associated with said computer (see [0025 and 0027], lines 5-7 where messages are displayed in a space of a web page and having user terminal to select the preferred form that can be viewed on a graphical, textual or audio and/or video *application*);

selecting a priority level for said application (see [0028], lines 1-4 whereby in a preferred embodiment provides for the attachment (selection) of start and end dates before and after which the message cannot be displayed, control of when a message is displayed is construed by examiner as setting a priority level); [also see [0026], line 3 a viewing priority for each Provider];

selecting at least one mode of presentment relating to said priority level, said mode of presentment operable for handling content presented on said computer via said application (see Fig. 3 whereby first row of matrix provides selection 'Sender/Messages 2C/priority/Block Sender');

storing selections made relating to said application, priority level, and said at least one mode of presentment (see [0030], lines 1-3 whereby an Administration Server (AS) provided with *storage* means in which user portfolios are *stored*).

As per claim 2, Schiff et al. further discloses:

indexing data relating to activities previously conducted on said computer system (see [0102], lines 1-3 whereby the AS give the user the option to see the

history of his messages at user's terminal; examiner construes indexing as a file
or directory on a server (definition from netlingo.com) and examiner construes
user's terminal to be said computer);

storing indexed data in a database (see [0030], lines 1-3 where AS has
means for storage and Fig 1B where AS in connected to databases such as
Clients Data Base);

upon receiving content associated with activities currently conducted on
said computer system, accessing said indexed data from said database (see
[0017], lines 1-3 whereby AS in which portfolios are stored, said AS being in
communication with a terminal belonging to a user; also where the AS has
access to the databases, Fig 1B, hence giving user access to databases);

comparing said content with said selections, resulting in a relevance
determination (see [0019], lines 1-3 whereby (the system) displays to one or
more users on their terminal, messages according to the information contained
in the user portfolio, examiner construes this matching of portfolio information
and messages for viewing as resulting in a relevance determination);

performing an action on said content in accordance with said relevance
determination and said settings (see [0022] lines 1-2 whereby an action
performed is debiting the Provider for messages displayed to said one or more
users (as the result of the relevance determination and said settings).

As per claim 3, Schiff et al. further discloses wherein said application includes at
least one of:

a messaging application (see [0016], lines 1-2 whereby the invention is
directed to a method for messaging over a data network);

a web browser application (see [0010], lines 1-3 whereby this invention
provide individual methods and systems for communication between surfers,
using their web browsers);

a word processing application (not expressly shown).

As per claim 4, Schiff et al. further discloses wherein said content includes at
least one of:

a web page (see Fig 2A);

an advertisement (see Fig 2A)'

and email (see Fig 2C, 'e-mail' under Message);

an instant message (see [0116], lines 1-4 citing FIG 6 with 3 examples of
messages, construed by examiner as 'instant messages');

a document (see [0156], line 11 it might also contain an XML file).

As per claim 5, Schiff et al. further discloses a system wherein said at least one
mode of presentment includes at least one of:

blocking said content (see [0166], line 8 Block Sender);

deleting said content (see [0166], line 9 Delete Company);

sending said content to a background screen of said computer system
(see [0051], lines 1-2d whereby in one embodiment the RCMS may decode the pre-
received *layout definition, construed by examiner to include background screen,* in order
to automate the dynamic insertion of the related information);

storing said content (see claim 38; although not explicitly shown, content can be forwarded anywhere in the network and in conjunction with storage means in the AS, storage of content is possible).

As per claim 6, Schiff et al. further discloses a system wherein said at least one mode of presentment includes at least one of:

changing an appearance (see [0119], lines 10-12 wherein the AS will change the messages appearance according to the portfolio of the person surfing the computer);

sending an audio signal to said user at said computer system (see [0078] via a cellular as type of communication); and

flashing a notification of an incoming message on said computer screen (see Fig 9 item 91 whereby instant messages appear, examiner construes real time changes to satisfy flashing specification).

As per claim 7, Schiff et al. discloses a system wherein said *changing an appearance of said content includes at least one of:*

*a **color**, a **font**, a **texture** and a **highlight*** (see [0114] via banner editor, video editor software and 3D animation editor; also see Fig 6A-6C for different font, color and highlight).

As per claim 8, Schiff et al. discloses a storage medium encoded with machine readable computer program code for filtering content presented on a computer (see [0044] lines 6-7 whereby software modules enables a program (with respect to AS)),

said storage medium including machine readable computer program code for causing a
computer to implement a method, comprising:

selecting an *application* (via messaging application) associated with said
computer (see [0025 and 0027], lines 5-7 where messages are displayed in a
space of a web page and having user terminal to select the preferred form that
can be viewed on a graphical, textual or audio and/or video *application*);

selecting a priority level for said application (see [0028], lines 1-4 whereby
in a preferred embodiment provides for the attachment (selection) of start and
end dates before and after which the message cannot be displayed, control of
when a message is displayed is construed by examiner as setting a priority level;
also see [0026], line 3 via viewing priority for each Provider);

selecting at least one mode of presentment relating to said priority level,
said mode of presentment operable for handling content presented on said
computer via said application (see Fig. 3 whereby first row of matrix provides
selection 'Sender/Messages 2C/priority/Block Sender');

storing selections made relating to said application, priority level, and said
at least one mode of presentment (see [0030], lines 1-3 whereby an
Administration Server (AS) provided with *storage* means in which user portfolios
are *stored*).

As per claim 9, Schiff et al. discloses the storage medium further comprising
instructions for causing said computer to implement:

indexing data relating to activities previously conducted on said computer system (see [0102], lines 1-3 whereby the AS give the user the option to see the history of his messages; examiner construes indexing as a file or directory on a server (definition from netlingo.com));

storing indexed data in a database (see [0030], lines 1-3 where AS has means for storage and Fig 1B where AS in connected to databases such as Clients Data Base);

upon receiving content associated with activities currently conducted on said computer system, accessing said indexed data from said database (see [0017], lines 1-3 whereby AS in which portfolios are stored, said AS being in communication with a terminal belonging to a user; also where the AS has access to the databases, Fig 1B, hence giving user access to databases);

comparing said content with said selections, resulting in a relevance determination (see [0019], lines 1-3 whereby (the system) displays to one or more users on their terminal, messages according to the information contained in the user portfolio, examiner construes this matching of portfolio information and messages for viewing as resulting in a relevance determination);

performing an action on said content in accordance with said relevance determination and said settings (see [0022] lines 1-2 whereby an action performed is debiting the Provider for messages displayed to said one or more users (as the result of the relevance determination and said settings).

As per claim 10, Schiff et al. discloses the storage medium wherein said application includes at least one of:

a messaging application (see [0016], lines 1-2 whereby the invention is directed to a method for messaging over a data network);

a web browser application (see [0010], lines 1-3 whereby this invention provide individual methods and systems for communication between surfers, using their web browsers);

a word processing application (not expressly shown).

As per claim 11, Schiff et al. discloses the storage medium wherein said content comprises at least one of:

a web page (see Fig 2A);

an advertisement (see Fig 2A)'

and email (see Fig 2C, 'e-mail' under Message);

an instant message (see Fig 9, item 91 and [0116], lines 1-4 citing FIG 6 with 3 examples of messages, construed by examiner as 'instant messages');

a document (see [0156], line 11 it might also contain an XML file).

As per claim 12, Schiff et al. discloses the storage medium wherein said at least one mode of presentment includes at least one of:

blocking said content (see [0166], line 8 Block Sender);

deleting said content (see [0166], line 9 Delete Company);

sending said content to a background screen of said computer system (see [0051], lines 1-2d whereby in one embodiment the RCMS may decode the pre-

received *layout definition, construed by examiner to include background screen,* in order

to automate the dynamic insertion of the related information);

   storing said content (see claim 38; although not explicitly shown, content

can be forwarded anywhere in the network and in conjunction with storage means in the

AS, storage of content is possible).

  As per claim 13, Schiff et al. discloses the storage medium wherein said at least

one mode of presentment includes at least one of:

   changing an appearance (see [0119], lines 10-12 wherein the AS will

   change the messages appearance according to the portfolio of the person surfing

   the computer);

   sending an audio signal to said user at said computer system (see [0078]

   via a cellular as type of communication); and

   flashing a notification of an incoming message on said computer screen

   (see Fig 9 item 91 whereby instant messages appear, examiner construes real

   time changes to satisfy flashing specification).

  As per claim 14, Schiff et al. discloses the storage medium wherein said

changing an appearance of said content further includes *changing at least* one

of:

   *a **color**, a **font**, a **texture** and a **highlight*** (see [0114] via banner editor,

video editor software and 3D animation editor; also see Fig 6A-6C for different font,

color and highlight).

As per claim 15, Schiff et al. discloses a system and method for filtering content presented on a computer system, said computer system in communication with a communication network, said system comprising:

at least one application (via messaging application) associated with said computer (see [0025 and 0027], lines 5-7 where messages are displayed in a space of a web page and having user terminal to select the preferred form that can be viewed on a graphical, textual or audio and/or video *application*);

an interface profile system executing on said computer system, said interface profile system including an index logic component and an evaluation logic component (see [0018], lines 1-4 whereby every user generates and updates a user portfolio containing information relative to Providers and/or individuals the messages of which the user is willing to view; examiner construes this portfolio information as the index logic component; see [0019], lines 1-3 whereby (the system) displays to one or more users on their terminal, messages according to the information (index logic component) contained in the user portfolio, examiner construes this matching of portfolio information and messages for viewing as the evaluation logic component);

a personal data index;

wherein said interface profile system (see [0017], lines 1-2 whereby an AS in which user portfolios are stored) performs:

selecting said at least one application (via messaging application) associated with said computer (see [0025 and 0027], lines 5-7 where

messages are displayed in a space of a web page and having user

terminal to select the preferred form that can be viewed on a graphical,

textual or audio and/or video *application*);

setting a priority level for said application (see [0028], lines 1-4

whereby in a preferred embodiment provides for the attachment

(selection) of start and end dates before and after which the message

cannot be displayed, control of when a message is displayed is construed

by examiner as setting a priority level); [also see [0026], line 3 a viewing

priority for each Provider);]

selecting at least one mode of presentment relating to said priority

level, said mode of presentment operable for handling content presented

on said computer via said application (see Fig. 3 whereby first row of

matrix provides selection 'Sender/Messages 2C/priority/Block Sender');

storing selections made relating to said at least one application,

said priority level, and said at least one mode of presentment (see claim

38; whereby content can be forwarded anywhere in the network and in

conjunction with storage means in the AS, storage of content is possible).

As per claim 16, Schiff et al. discloses the system wherein said interface profile

system further performs:

indexing data relating to activities previously conducted on said computer

system (see [0102], lines 1-3 whereby the AS give the user the option to see the

history of his messages; examiner construes indexing as a file or directory on a
server (definition from netlingo.com));

storing indexed data in a database (see [0030], lines 1-3 where AS has
means for storage and Fig 1B where AS in connected to databases such as
Clients Data Base);

upon receiving content associated with activities currently conducted on
said computer system, accessing said indexed data from said database (see
[0017], lines 1-3 whereby AS in which portfolios are stored, said AS being in
communication with a terminal belonging to a user; also where the AS has
access to the databases, Fig 1B, hence giving user access to databases);

comparing said content with said selections, resulting in a relevance
determination (see [0019], lines 1-3 whereby (the system) displays to one or
more users on their terminal, messages according to the information contained
in the user portfolio, examiner construes this matching of portfolio information
and messages for viewing as resulting in a relevance determination);

performing an action on said content in accordance with said relevance
determination and said settings (see [0022] lines 1-2 whereby an action
performed is debiting the Provider for messages displayed to said one or more
users (as the result of the relevance determination and said settings).

As per claim 17, Schiff et al. discloses the system wherein said application
includes at least one of:

a messaging application (see [0016], lines 1-2 whereby the invention is

directed to a method for messaging over a data network);

a web browser application (see [0010], lines 1-3 whereby this invention

provide individual methods and systems for communication between surfers,

using their web browsers);

a word processing application (not expressly shown).

As per claim 18, Schiff et al. discloses the system wherein said content includes

at least one of:

a web page (see Fig 2A);

an advertisement (see Fig 2A)'

and email (see Fig 2C, 'e-mail' under Message);

an instant message (see [0116], lines 1-4 citing FIG 6 with 3 examples of

messages, construed by examiner as 'instant messages');

a document (see [0156], line 11 it might also contain an XML file).

As per claim 19, Schiff et al. discloses the system wherein said at least one

mode of presentment includes at least one of:

blocking said content (see [0166], line 8 Block Sender);

deleting said content (see [0166], line 9 Delete Company);

sending said content to a background screen of said computer system

(see [0051], lines 1-2d whereby in one embodiment the RCMS may

decode the pre-received *layout definition, construed by examiner to*

include background screen, in order to automate the dynamic insertion of

the related information);

storing said content (see claim 38; although not explicitly shown, content

can be forwarded anywhere in the network and in conjunction with storage

means in the AS, storage of content is possible).

As per claim 20, Schiff et al. discloses the system wherein at least one mode of

presentment includes at least one of:

changing an appearance (see [0119], lines 10-12 wherein the AS will

change the messages appearance according to the portfolio of the person surfing the

computer);

sending an audio signal to said user at said computer system (see [0078]

via a cellular as type of communication); and

flashing a notification of an incoming message on said computer screen

(see Fig 9 item 91 whereby instant messages appear, examiner construes real

time changes to satisfy flashing specification).

As per claim 21, the system wherein said changing an appearance of said

content *includes at least one of*:

a color, a font, a texture and a highlight (see [0114] via banner editor,

video editor software and 3D animation editor; also see Fig 6A-6C for different

font, color and highlight).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

        Axe et al. (20050055271) discloses a method and system for identifying
and/or blocking ads such as document-specific competitive ads.

        Marsh et al. (6879974) discloses a system and method for scheduling the
presentation of messages to users.

        Serena (6912571) discloses a method of controlling and monitoring
content in an application program or content exchanged between the application
program and an operating system residing at the user's computer system.

        Zellner (20050108360) discloses a method, system and storage medium
for validating users of communications services and messages transmitted.

        Huret (7103592) discloses a method and apparatus providing
recommendations based on automatically enriched user profile.

7.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Michael H. Goldman whose telephone number is 571-
274-5101. The examiner can normally be reached on Monday thru Thursday 6:30am-
5:00pm.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg

/Lynda Jasmin/

Supervisory Patent Examiner, Art Unit 4127